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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
HUSON, MONICA ANNE	
ART UNIT	**PAPER NUMBER**
1732	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/827,482	FITCH ET AL.	
	Examiner	Art Unit	
	Monica A. Huson	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *041904*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 26, 27, 29, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26, 27, 29, and 30 recite the limitation "the co-polyester layer" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by McGrail et al. (U.S. Patent 4,252,885). Regarding Claim 16, McGrail shows that it is known to carry out a method of producing a coated directly embossable PET film (Column 4, lines 16-22; the substrate will become embossed during transverse stretching of the coated film), including stretching a PET film to form a uniaxially oriented PET film and drying the uniaxially oriented PET film (Column 7, lines 14-17); coating at least one surface of the uniaxially oriented PET film with an aqueous solution of an organic material (Column 7, lines 16-17); and rendering at least one surface of a resulting coated uniaxially oriented PET film susceptible to direct embossing by impregnation of the surface of the uniaxially oriented PET film with at least a portion of the coating by transverse stretching the coated uniaxially oriented PET film (Column 7, lines 17-20).

Regarding Claim 31, McGrail et al., hereafter "McGrail," show that it is known to carry out a method of producing a directly embossable substrate (Column 4, lines 16-22; the substrate will become embossed during transverse stretching of the coated film), comprising inline coating a uniaxially oriented PET film with about 0.2 um thickness of non-crosslinked polyester dispersion (Column 3, lines 53-56, 65-68; Column 4, lines 1-22; Column 16, lines

16-20), drying the coating (Column 7, lines 16-17); and transverse stretching the resulting coated film (Column 7, lines 17-20).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGrail, in view of Hellmann et al. (U.S. Patent 6,238,782).

Regarding Claim 17, McGrail shows the process as claimed as discussed in the rejection of Claim 16 above, but he does not show coextruding the PET base film. Hellmann et al., hereafter "Hellmann," show that it is known to carry out a method of making a biaxially oriented polyester film including a method wherein the PET base film is coextruded and forms at least two layers (Column 6, lines 27-31). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hellmann's coextruded PET base film as that during McGrail's molding process in order to make a material having different properties attributed to each layer (See Hellmann, Column 2, lines 55-65).

Regarding Claim 18, McGrail shows the process as claimed as discussed in the rejection of Claim 16 above, but he does not show the claimed PET film thickness. Hellmann shows that it is known to carry out a method wherein the PET film has a thickness of 5-40 um (Column 6, lines 16-18). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to form Hellmann's specific thickness of film during McGrail's molding process in order to accommodate particular end-use specifications and requirements.

Regarding Claims 19 and 20, McGrail shows the process as claimed as discussed in the rejection of Claim 16 above, but he does not show a PET film that contains particles. Hellmann shows that it is known to carry out a method wherein the PET contains particles of silica (Column 5, lines 27-29). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hellmann's silica particles in the film of McGrail in order to lend particular properties of the particles to the final molded article.

Regarding Claim 21, McGrail shows the process as claimed as discussed in the rejection of Claim 19 above, but he does not show a particular concentration of particles in his PET film.

Hellmann shows that it is know to carry out a method wherein particles are present in an amount of 0.1 weight % (Column 5, lines 41-42). It would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made to use Hellmann's concentration of particles in the PET film of McGrail in order to accommodate particular end-use specifications and requirements and lend particular properties to particular layers of the final article.

Regarding Claims 22 and 23, McGrail shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the PET film is stretched about three times its original dimensions (Column 7, lines 14-20; It is interpreted that about 3 meets the claimed limitation of about 3.3 or about 3.4.), meeting applicant's claim.

Regarding Claim 24, McGrail shows the process as claimed as discussed in the rejection of Claim 17 above, including a method wherein the coating is formed from a non-crosslinked polyester dispersion (Column 3, lines 53-56), meeting applicant's claim.

Regarding Claim 25, McGrail shows the process as claimed as discussed in the rejection of Claim 16 above, including a method wherein the coating has a thickness of 0.2 um (Column 16, lines 16-20), meeting applicant's claim.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 16, 18-25, and 28 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 17-26 and 29, respectively, of prior U.S. Patent No. 6,737,170. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the

reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 17 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 18 of U.S. Patent No. 6,737,170. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claim is fully encompassed by the claim of the '170 patent.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica A. Huson whose telephone number is 571-272-1198. The examiner can normally be reached on Monday-Friday 7:00am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Monica A Huson

Monica A Huson
September 12, 2007